

REMARKS

In the Office Action the Examiner noted that claims 1-12 and 14-15 are pending in the application, and the Examiner rejected all claims. By this Amendment, the abstract and claims 1-3, 9-12, and 14-15 have been amended. No new matter has been presented. Thus, claims 1-12 and 14-15 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Objection To the Abstract

In items 2-3 on pages 2-3 of the Office Action the Examiner objected to the abstract of the application, alleging that the amended abstract did not include the novel part of what the Examiner characterized as the "invention".

By this Amendment, the abstract has been amended and includes language stating, "In an advertising display process, an advertisement is sent from the advertising server to a second user terminal in accordance with browsing by a first user terminal, and the advertisement is displayed at the second user terminal." Therefore, the Applicants respectfully request that the Examiner withdraw the objection to the abstract.

Claim Rejections Under 35 USC §112

In item 5 on pages 3-5 of the Office Action the Examiner rejected claims 1 and 14 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner cited examples from claims 1 and 14 that allegedly provided basis for the §112 rejections.

By this Amendment, claims 1 and 14 have been amended and no longer recite the language in the form rejected to by the Examiner. Therefore, the Applicants respectfully request the withdrawal of the Examiner's §112 rejections of these claims.

Claim Rejections Under 35 USC §103

In item 7 on pages 5-9 of the Office Action the Examiner rejected claims 1-4, 9-10, 12, and 14-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,699,125,

issued to Kirmse et al. (hereinafter referred to as "Kirmse"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 1, as amended, recites "correlatively recording in an advertising database resource identification information specifying a resource on the network with a plurality of advertising information, including a plurality of image data.... [and] extracting first advertising information corresponding to the resource identification information, and recorded in said recording, for the first resource detected in said detection, wherein the extracted first advertising information is chosen from the recorded plurality of advertising information correlated to the resource identification information." Support for the amendments to this claim can be found at least in lines 1-19 on page 37 of the application. The Applicants respectfully submit that Kirmse does not disclose or suggest at least these features of claim 1.

Kirmse discloses a game and messenger client-server system in which a second user, registered on a buddy list with a first user, is notified when the first user is playing a game. The notification indicates to the second user what game the first user is playing, and operates as an invitation to the second user to join the game in which the first user is playing. The Examiner has characterized the invitation for the second user to join the game as the advertising information recited in claim 1.

The Applicants respectfully submit that no one skilled in the art would characterize the game invitation of Kirmse as the advertising information recited in claim 1, the advertising information being further described in the description of the related art in the present application as generating revenue to support services offered free of charge on the internet. However, even assuming, *arguendo*, that the game invitation of Kirmse could be characterized as advertising information, Kirmse does not disclose or suggest recording a plurality of advertising information correlated with resource identification information specifying a resource on the network, and choosing first advertising information to be broadcast from the recorded plurality of advertising information. Kirmse merely sends identification information identifying a game being played by the first user. This is in direct contrast with claim 1 of the present application. Further, there would be no reason to modify Kirmse to choose from a plurality of invitations to join any particular game, because in Kirmse the only aspect being communicated is the game itself being played by the first user. However, in at least one described embodiment enabled by the features recited in claim 1, a plurality of advertising information, which may include an advertisement for an owner of the resource being used by the first user as well as a product recommended by that owner, is recorded and chosen from to be displayed to the second user.

Therefore, Kirmse neither discloses, suggests, nor even contemplates at least the features of “correlatively recording in an advertising database resource identification information specifying a resource on the network with a plurality of advertising information, including a plurality of image data.... [and] extracting first advertising information corresponding to the resource identification information, and recorded in said recording, for the first resource detected in said detection, wherein the extracted first advertising information is chosen from the recorded plurality of advertising information correlated to the resource identification information”, as recited in claim 1 of the present application. Further, these features are not obvious modifications of Kirmse, and in fact are taught away from by Kirmse. Thus, the Applicants respectfully submit that claim 1 patentably distinguishes over Kirmse, and further respectfully requests the withdrawal of the Examiner’s §103 rejection of claim 1.

Claims 2, 9-10, 12, and 14-15 all recite similar features to those discussed in regard to claim 1, and which are not disclosed or suggested by Kirmse, those features pertaining to a plurality of advertising information being chosen from for the display to a second user. Therefore, it is respectfully submitted that claims 2, 9-10, 12, and 14-15 also patentably distinguish over Kirmse.

Claims 3-4 depend from claim 2 and include all of the features of that claim plus additional features which are not disclosed or suggested by Kirmse. Therefore, it is respectfully submitted that claims 3-4 also patentably distinguish over Kirmse.

Also, regarding claims 2, 4, and 9, the Examiner stated that accepting new (unregistered) information from clients and correlating new information with other clients’ data already belonging to the same clients is well known. The Examiner made a similar allegation of Official Notice regarding the correlation of advertisement information with resource identification information. The Applicants respectfully traverse the Examiner’s statement, and further request that the Examiner produce authority for the statement. The Applicants specifically point out the following errors in the Examiner’s action.

First, the Examiner uses common knowledge (“well-known”) evidence for the rejection. As explained in the M.P.E.P.,

any facts so noticed should... server only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based.

M.P.E.P. § 2144.03

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention (see, M.P.E.P. § 2144.03(A) (the notice of facts beyond the record which may be taken by the Examiner must be “capable of such instant and unquestionable demonstration as to defy dispute”).

Third, there is no evidence supporting the Examiner's assertion (see, M.P.E.P. § 2144.03(B) (“there must be some form of evidence in the record to support an assertion of common knowledge”).

Fourth, the Examiner appears to be basing the rejections, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such assertion with an affidavit when called for by the Applicant. The Examiner is called upon to support such assertion.

Further, even if the Examiner's assertion and rejection based on common knowledge could be considered valid, *arguendo*, this has no bearing on the fact that the features of the independent claims discussed above patentably distinguish over Kirmse. As discussed above, only an invitation to join a game is presented to the second user as a status of the first user, and this invitation is not chosen from a plurality of invitations. The Examiner stated that it would be obvious to add these “customary methods” to Kirmse to allow adding new advertising data such as new details of the game discussed in Column 9, Lines 43-46 of Kirmse. However, these new game details discussed in Kirmse are not presented as the status of the first user, but are only available as a menu after the second user of Kirmse clicks on the invitation icon.

Therefore, because this additional information cited by the Examiner is not presented as the status of the first user in Kirmse, there is no motivation to combine those “customary methods” to attempt to form a rejection of claim 1, or any other independent claims, of the present application. Thus, not only does Kirmse not disclose the features previously discussed in this Amendment, there is no motivation for modifying Kirmse in the fashion suggested by the Examiner. In fact, as previously stated, Kirmse teaches away from any such modification.

In item 8 on pages 9-11 of the Office Action the Examiner rejected claims 5-8 and 11 under 35 U.S.C. §103 as being unpatentable over Kirmse in view of Recommend-it (a set of documents recited by the Examiner) and U.S. Patent No. 5,794,210, issued to Goldhaber et al.

(hereinafter referred to as "Goldhaber"). The Applicants respectfully traverse the Examiner's rejections of these claims.

As previously discussed in this Amendment, claim 2 patentably distinguishes over Kirmse for at least the discussed reasons. Further, as Recommend-it apparently merely discloses sending an email with "juicy details" about a visited site, and Goldhaber apparently merely discloses award conditions for a user based on access to ads, Recommend-it and Goldhaber do not cure the deficiencies of Kirmse in regard to claim 2. Also, Kirmse completely teaches away from any combination with Recommend-it, as the relative delay and complication of email is not compatible with the instant messaging system disclosed in Kirmse. Therefore, as claims 5-8 depend from claim 2 and include all of the features of that claim plus additional features which are not disclosed or suggested by the cited references, it is respectfully submitted that claims 5-8 also patentably distinguish over the cited references.

Further, claim 11 of the present application, as amended, recites "acquiring and sending to the look-up requestor user terminal at least one chosen from a plurality of advertising data correlatively stored for each network resource on receiving requests in advance from an advertiser terminal device". As discussed previously in this Amendment, none of the cited references disclose or suggest at least this feature of claim 11. Therefore, it is respectfully submitted that claim 11 also patentably distinguishes over the cited references.

Summary

In accordance with the foregoing, the abstract and claims 1-3, 9-12, and 14-15 have been amended. No new matter has been presented. Thus, claims 1-12 and 14-15 remain pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

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Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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